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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,857	02/22/2002	Shinsuke Takahashi	Q68660	7570
23373	7590	08/11/2004	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			KIM, SANG K	
			ART UNIT	PAPER NUMBER
			3654	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/079,857	Applicant(s) TAKAHASHI ET AL.	
	Examiner SANG KIM	Art Unit 3654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-13,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,6-9,18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 6, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2030968 A.

GB '968 shows a roller (10) with chamfered portions (12) formed at both end portions of an outer peripheral surface thereof, wherein portions of a web (w') is aligned across from the outer peripheral surface of the chamfered portions (12) and both edges of the web extends from edges of a straight portion (11, 14) of the roller, and width of the web contacts the outer peripheral surface of the roller (10), as shown in figures 2-3.

GB '968 discloses the claimed invention expect for a specific range in width of the web extending from both edges of the straight portion roller and a range of angles of the chamfered portions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a certain range in width and angle as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Further, the recited range of widths is consistent with the usual and expected scale and dimensions of a machine of the type disclosed by the reference, that is, a corrugating machine.

With respect to claims 18-19, GB '968 shows each of the chamfered portions has a curved surface, on page 1, lines 110-117 and figure 2.

The recitation in the claims that the apparatus has a paster roller, relates only to a possible or intended use of the device being claimed, but does not further structurally limit the device, since "the paster roller" is a self-contained description of the roller and no structures are corresponding to "the paster roller".

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2030968 A, in view of Carlson, U.S. Patent No. 4756065.

GB '968 does not show a coated elastic body on the outer peripheral surface of the core bar, but understands that the roller can have a resilient covering which affects the web tension, see page 1, lines 63-65.

Carlson shows a coated elastic body (13) on the outer peripheral surface of the aluminum core bar, as shown in figures 2 and 4.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of GB '968, to add a coated elastic body as taught by Carlson, to minimize the shearing force exerted on the roller when it comes into contact with a rapidly moving web.

GB '968 in view of Carlson discloses the claimed invention expect for a specific hardness range of the coated elastic body from 40 to 70. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a certain range of hardness as claimed, since it has been held that where the general conditions

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of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Response to Arguments

Claims 1-3 and 10-13 are withdrawn from further consideration.

Claims 5 and 14-17 have been canceled.

Claims 18-19 have been added.

The Office Action Summary of box 6 has been corrected due to a typographical error.

Applicant's arguments filed on 6/10/04 have been fully considered but they are not persuasive with respect to claims 4, 6-9 and 18-19.

Applicant argues that GB '968 does not make obvious the features of claim 4 regarding the claimed range of 20 mm to 50 mm because it is settled law that a particular parameter first must be recognized as a result-effective variable before the determination of the optimum or workable ranges of the variable can be characterized as routine experimentation.

As stated above, GB '968 does recognize and address the distance that the web W' extends over the taped end 12. As explained on page 2, lines 99-119, and shown in figures 2-3. "Each tapered end 12 of the roller R is located so that it underlies the edge margin W' of the web W trained around that roller." Furthermore, the angle is selected so the contact between the web and the roller can be adjusted. Since, the prior art

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does recognize the distance of how far the web edges can be adjusted with respect to the roller's chamfered portions, and therefore the parameter optimized was recognized in the art to be a result-effective variable. (Emphasis added).

Applicant argues with respect to claim 9 (encompassed by claim 4 arguments) that the references fail to teach or suggest that the hardness aspect is a result-effective variable. Thus, the combination of the applied references would not have taught or suggested the claimed features.

As stated above, GB '968 does not show a coated elastic body on the outer peripheral surface of the core bar, but understands that the roller can have a resilient covering which affects the web tension, see page 1, lines 63-65.

Carlson shows a coated elastic body (13) on the outer peripheral surface of the aluminum core bar, as shown in figures 2 and 4.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of GB '968, to add a coated elastic body as taught by Carlson, to minimize the shearing force exerted on the roller when it comes into contact with a rapidly moving web.

GB '968 in view of Carlson discloses the claimed invention expect for a specific hardness range of the coated elastic body from 40 to 70. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a certain range of hardness as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

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Since, the prior art does recognize the roller can have a resilient covering which affects the web tension, and therefore the parameter optimized was recognized in the art to be a result-effective variable. (Emphasis added).

With respect to applicant's comments regarding the optimization of ranges, it is noted that the generic principles advanced in MPEP 2144.05 (II)(A) apply to any quantifiable feature of an invention, not merely to concentrations and temperatures.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sang Kim whose telephone number is (703) 305-3712. The examiner can normally be reached Monday through Friday from 8:00 A.M. to 5:30 P.M. alternating Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on (703) 308-2688. The fax phone numbers are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

SK

7/31/04

A handwritten signature in black ink that reads "Kathy Matecki". The signature is written in a cursive, flowing style.

KATHY MATECKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600